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IN THE

Supreme Court of the United States

OCTOBER TERM, 1968

No. 442

MARVIN K. SWOFFORD, MARION F. WRIGHT AND ESSEX CORPORATION, d/b/a THE PATHFINDER COMPANY,

Petitioners,

v.

B & W, INC.,
(And Reverse Title)

Respondent.

PETITION FOR REHEARING FOR WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE FIFTH CIRCUIT

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FIDELITY PRINTING COMPANY, INC., HOUSTON

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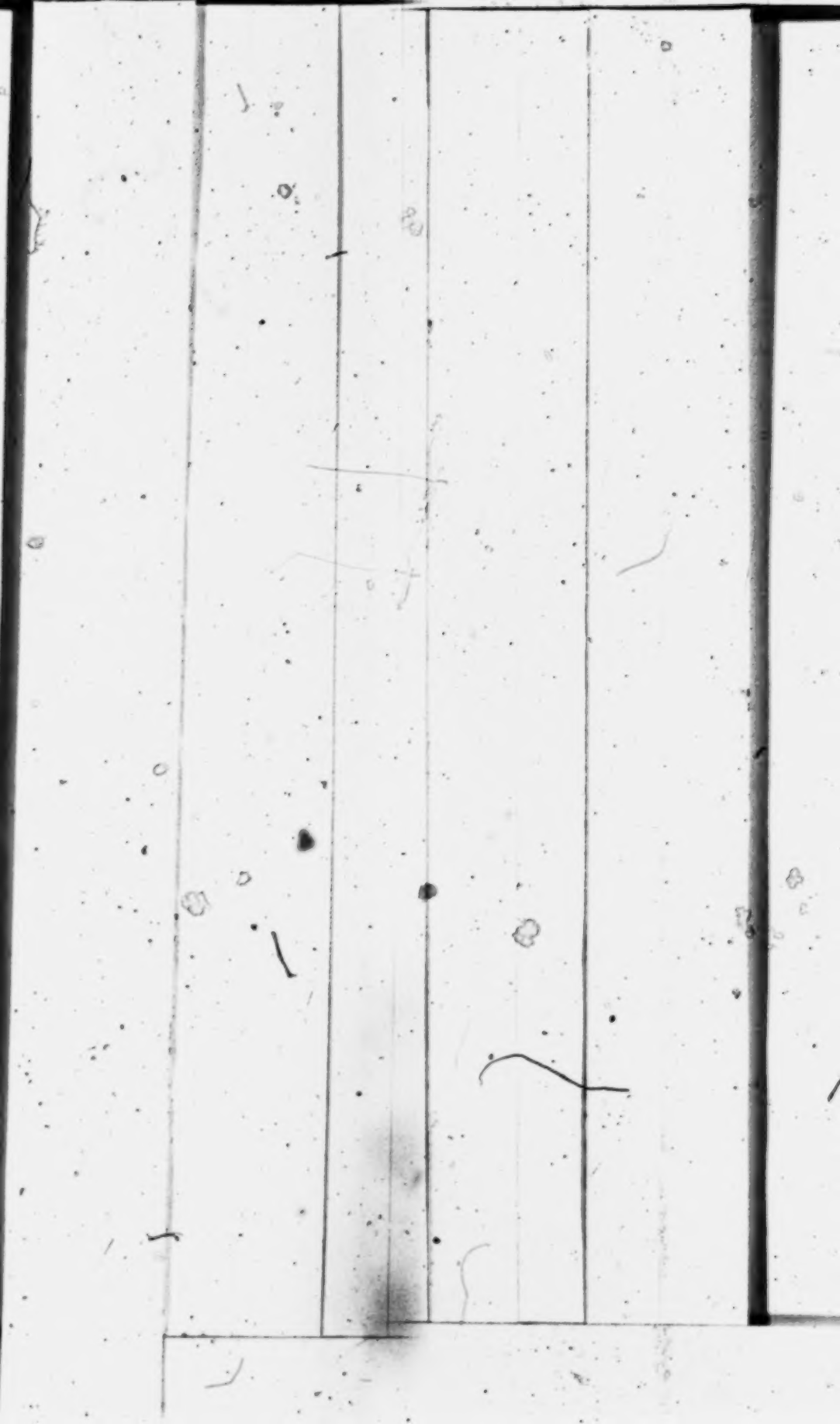

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Petitioners pray for a rehearing of their application that a Writ of Certiorari issue to review the decision of the United States Court of Appeals for the Fifth Circuit in this cause.

The intervening circumstance which gives rise to this Petition for Rehearing is that shortly before the denial of the petitioners' application for Writ of Certiorari in this case, the Court of Appeals for the Fourth Circuit rendered

its decision in *Porter-Cable Machine Co.* v. *Black & Decker Mfg. Co.*, ... F. 2d ..... (4 cir., 1968) 159 U.S.P.Q. 65, holding that "obviousness" is a question of fact under the aegis of Rule 52(a) F.R.Civ.P., which is in direct conflict with the rule of law applied by the Court of Appeals for the Fifth Circuit in the present Case.

Petitioners understand that application for Writ of Certiorari was or is to be filed with this Court on or about December 6, 1968, requesting review of the decision by the Court of Appeals for the Fourth Circuit in the *Porter-Cable* case, *supra*, and therefore there are now contemporaneously before this Court two Petitions for Writs of Certiorari from two circuits on the same basic point of law wherein the circuits each hold diametrically opposed views.

Petitioners file this Petition for Rehearing of their Writ of Certiorari in this Court requesting review of a decision by the Court of Appeals of the Fifth Circuit which held that the non-obviousness of an invention, which is a basic statutory condition for patentability, constitutes a question of law rather than a question of fact. In addition to correction of an erroneous conclusion in this particular case, review by this Court is sought to clarify a state of confusion which presently permeates the judicial determination of this basic statutory element of patent validity in the large segment of patent infringement cases in which this question is raised.

Petitioners seek a rehearing of their application for their Writ of Certiorari with the Fifth Circuit to emphasize and reiterate the urgent need for this Court to give its attention to this problem, as there is growing confusion among the lower Courts and particularly among the various circuits, regarding the proper understanding and characterization of the basic and often critical question of "non-obviousness"

in patent infringement litigation. The resolution of this basic question is of paramount importance to Courts and litigants alike in the sound administration of the patent laws.

To reconcile the growing conflict among the Courts of Appeals for the various circuits and among the lower Courts as well, it is respectfully submitted that this Court grant petitioners' motion for rehearing of their application for Writ of Certiorari to the United States Court of Appeals for the Fifth Circuit in this case, and avail itself of this opportunity to lay to rest this pernicious problem which enshrouds patent infringement litigation with a pall of uncertainty around this basic criteria of patent validity.

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CERTIFICATE OF ATTORNEY

I hereby certify that the foregoing "Petition for Rehearing of Petition for Writ of Certiorari to United States Court of Appeals for the Fifth Circuit" is presented in good faith, and not for delay, and is grounded on the conflict between the law in the Fifth Circuit as evidenced by the case at bar and the law in the Fourth Circuit, as evidenced by the subsequent decision of that Court in *Porter-Cable Machine Co.* v. *Black & Decker Mfg. Co., supra,* which concurrently presents a conflict on the same basic issue arising in a different circuit.

.....

Jack W. Hayden
Attorney for Petitioners

CERTIFICATE OF SERVICE

Service of this Petition has been made upon B & W, Inc., Respondent by depositing a copy in a United States mail box, first class postage prepaid to Tom Arnold, Esq., 2220 Tennessee Building, Houston, Texas 77002, on December ....., 1968, and by depositing a copy in a United States mail box, air mail postage prepaid to each R. Douglas Lyon, Esq., and James H. Mitchell, Esq. at 811 West Seventh Street, and 727 West Seventh Street, respectively, Los Angeles, California 90017, on December ....., 1968.

.....

Jack W. Hayden
Attorney for Petitioners